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09/249,660 02/12/99 NAKAJO

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EXAMINER

WM01/0216

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ART UNIT

PAPER NUMBER

2651

DATE MAILED:

02/16/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

1- File Copy

# Office Action Summary

Application No.

09/249,660

Applicant(s)

NAKAJO, YUKIHISA

Examiner

Aristotelis M Psitos

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### DETAILED ACTION

Applicant's communication of 1/4/2001 has been received. The following action is in response.

1. Applicant's election with traverse of the species (b) indicated on page 2 in the OA of 12/7/00 in Paper No. 5, dated 1/4/01 is acknowledged. The traversal is on the ground(s) that no undue burden is placed on examiner. This is not found persuasive because the election requirement is under species.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-3 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

Claims 4-8 are examined under the merits, and claims 9-12 has been canceled by applicant's response of 1/4/01.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4-5 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reading the above claims, it is noted that the examiner and applicant disagree as to what claims read on the elected species. Applicant's attention is drawn to MPEP § 821.

The examiner determined that species (b) is disclosed on pages 30-32 of the specification.

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As found therein, there is an offset capability predicated on stored information indicative of optimum offset values – element 64. Such an element is not found in the above claims, and does not read on the elected species.

Claims 6 and 7 are duplicative. The examiner can not ascertain any patentable difference between the claims, and hence they are considered to be duplicative of one another. The examiner suggests, canceling claim 6 for instance. Claim 8 doesn't correct the above problem and falls with its parent claim.

As far as the claims recite positive limitations the following rejections are made.

6. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by either the acknowledged prior art or Aoshima.

As far as the examiner can determine, claim 4 recites the acknowledged prior art system disclosed on page. 7, HEI 1-325634. A copy and English translation of such prior art is respectfully requested in order to complete the search report.

Also, Aoshima provides for a tracking error signal system, in which during periods of no recording, no beam power, a tracking error signal is developed, and that during other periods a held values is provided for – see the description at col. 4, lines 57 plus for instance.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaku et al – depicting the ability of having a tracking error signal during a non-recording period, and no tracking offset during recording/erasing operation as disclosed.

#### ***Allowable Subject Matter***

7. Claims 7 and 8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on 8-4 EST , M-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6606 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
Aristotelis M. Psitos  
Primary Examiner  
Art Unit 2651

amp  
February 14, 2001